

### **Remarks**

Claims 25-38 and 40-48 are pending in this Application. Claims 1-24, 39 and 49-67 have been previously canceled without prejudice.

In the Office Action mailed on August 25, 2008, the Examiner rejected the pending claims under 35 U.S.C. § 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a), as being unpatentable over JP 11-010631 (hereinafter, "Yamada" and referred to in previous Amendments submitted by Applicants as "Matsushita").

Applicants with this paper respectfully reiterate a position that Yamada does not expressly or implicitly teach or suggest Applicants' claimed invention. In addition, the Yamada reference is not obvious over Applicants' claimed invention. By way of a Declaration submitted under 37 C.F.R. 1.132, timely presented as Exhibit A and executed by another having experience in the area of cellulose and paper chemistry and wood sciences, Applicants traverse the rejection and provide objective evidence that Yamada does not anticipate nor can it be considered obvious over the claimed invention. Exhibit A should be given substantial weight with regard to the rejection of anticipation or obviousness because Exhibit A is highly relevant to the subject matter as claimed. Applicants respectfully submit that there is a nexus (factual and sufficient connection) between the objective evidence of nonobviousness and lack of anticipation submitted as Exhibit A and the claimed invention, so that the evidence (Exhibit A) is of probative value in the determination of both the lack of anticipation and nonobviousness.

Exhibit A specifically states that Yamada cannot be used or relied on to provide a method for measuring COD of cellulose fibers. Exhibit A further states that Yamada does not provide an enabling description of how COD is determined because Yamada is lacking in its written description. Methods and standards for measuring COD from cellulose fibers are well-known and available and such methods or standards conflict with what is disclosed by Yamada. Exhibit A also states that COD in fibers cannot be measured as disclosed in Yamada, including the teachings of paragraphs [0005] and [0007] of Yamada, because, among other things, Yamada

measures COD from a cement mixture, which cannot be used to measure COD from cellulose fibers. Cement is known to introduce additional degradation compounds with a chemical oxygen demand that is separate from the COD content associated with cellulose fibers. COD compounds may accumulate in waste water that is recycled in a cement making process; however, COD content cannot be accurately or reliably recorded from a cement mixture after only 5 minutes of mixing as disclosed by Yamada at paragraphs [0005] and [0007]. Exhibit A concludes by stating that, contrary to the Examiner's statement on page 3 of the Office Action, Yamada's cement mixture having a COD of 5 ppm cannot be used to describe or identify a COD value for cellulose fibers. As such, Exhibit A states that Yamada does not anticipate and Yamada is not obvious over the claims presented in the Application for patent.

Applicants also respectfully request the Examiner consider again a Declaration submitted under 37 C.F.R. 1.132, timely presented with an Amendment dated July 29, 2008. This Declaration submitted July 29, 2008, states, among other things, that there is no express disclosure by Yamada about how to measure COD of cellulose fibers because Yamada teaches only how to measure COD from a cement mixture, which is not the same nor can it be considered an equivalent measurement. The Declaration submitted July 29, 2008t, states that there is no correlation between a COD value measured from a cement mixture containing fibers (as disclosed by Yamada) and COD value measured from cellulose fibers (as disclosed by Applicant's claimed invention); the Declaration submitted on July 29, 2008, provided further supporting evidence of the same in the form of Table 1. The objective evidence submitted on July 29, 2008, is considered relevant to the subject matter as claimed. Furthermore, Applicant believes there is a nexus between the merits of the claimed invention and the objective evidence of nonobviousness and lack of anticipation submitted on July 29, 2008, that warrants its reconsideration.

Applicants respectfully submit that after evaluating the evidence provided herewith and described above, the Examiner should be convinced that the claimed invention is patentable. Applicants find that there is no *prima facie* case that has been presented by the Examiner to maintain the rejection under 35 U.S.C. § 102(b) or, in the alternative, under 35 U.S.C. § 103(a).

Applicants have submitted timely evidence traversing the rejection with a preponderance of objective evidence of nonobviousness and lack of anticipation. Accordingly, Applicants respectfully request the rejections be withdrawn.

### **Conclusion**

Applicants respectfully submit that the Application is in condition for allowance, and pursuant to the filing of this paper and the accompanying documents, Applicants earnestly seek such allowance of Claims 25-38 and 40-48 as provided in the Listing of Claims beginning on page 3 of this paper.

Should the Examiner have questions, comments, or suggestions in furtherance of the prosecution of this Application, please contact Applicants' representative at 214.999.4330. Applicants, through their representative, stand ready to conduct a telephone interview with the Examiner to review this Application if the Examiner believes that such an interview would assist in the advancement of this Application.

This paper is submitted concurrently with a Petition for Extension of Time with the appropriate fees.

To the extent that any further fees are required with this filing, the Commissioner is hereby authorized to charge payment of any additional fees to Deposit Account No. 07-0153 of Gardere Wynne Sewell LLP and to reference Attorney Docket No. 129843-1022. In the event that any additional time is needed for this filing, or any additional time in excess of that requested in a petition for an extension of time, please consider this a petition for an extension of time for any needed extension of time pursuant to 37 C.F.R. § 1.136 or any other section or provision of Title 37. Applicants respectfully request that the Commissioner grant any such petition and authorize the Commissioner to charge the Deposit Account referenced above. Please credit any overpayments to this same Deposit Account.

This is intended to be a complete response to an Office Action mailed August 25, 2008.

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AMENDMENT  
Application No. 09/970,389

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**Please direct all correspondence to the practitioner listed below at Customer No. 60148.**

Respectfully submitted,



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